

6  
2/19/04



Docket No.: 20136-00328-US  
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Patent Application of:  
Mark L. Ernest et al.

Application No.: 10/005,862

Confirmation No.: 2036

Filed: November 8, 2001

Art Unit: 2161

For: AUTOMATED INFORMATION  
TECHNOLOGY MANAGEMENT SYSTEM

Examiner: D. B. Van

BRIEF ON APPEAL UNDER 37 C.F.R. § 1.192

MS Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This brief is in furtherance of the Notice of Appeal, filed in this case on October 7, 2003.

The fees required under § 1.17(f) and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief is transmitted in triplicate.

This brief contains items under the following headings as required by 37 C.F.R. § 1.192 and M.P.E.P. § 1206:

I. Real Party In Interest

The real party in interest is the International Business Machines, Corporation, assignee of the present application.

01/21/2004 MGEBREM1 00000051 090458 10005862

01 FC:1402 330.00 DA

RECEIVED  
JAN 28 2004  
GROUP 3600

II. Related Appeals and Interferences

There are no related appeals or interferences regarding the application which will directly effect or be directly effected by or having a bearing on the Boards decision in the pending appeal.

III. Status of Claims

Claims 1-16 are pending in the application and are on appeal. No claims have been cancelled.

IV. Status of Amendments

There are no unentered amendments filed subsequent to the Final Rejection.

V. Summary of Invention

The present application relates to a system and process for managing an integrated information technology (IT) system. The invention provides for an evaluation of the system on an on-going basis by collecting from each of the system's components usage data indicating an amount of use each component receives in providing a given service. Fig. 3 of the present application shows one such system wherein each of the components have an agent 24 to collect usage information. The agent 24 monitors usage of a particular component during a business transaction. This information is compiled in a table as shown in Fig. 2, so that a component value in the system may be determined. Additionally, the value of each transaction type to the system proprietor may be determined as shown in Fig. 4. By extending the reach and range of business data down to individual IT components, technical decisions can be made such as a reallocation of resources and an optimal time for replacement or the up-grade of components.

## VI. Grouping of the Claims

The following groups of claims stand or fall together.

- A. Claims 1-2, 5
- B. Claim 3, 11
- C. Claim 4, 13
- D. Claims 6, 7, 8 and 9
- E. Claims 10, 12
- F. Claims 14, 15, 16

## VII. Argument

The Final Rejection contains a single rejection under 35 U.S.C. § 102. As set forth in the Office Action mailed February 13, 2003, claims 1-16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Agrawal et al. (EP 0 895 169 A2).

The rejection of the patent application is based on the conclusion that each of the claims 1-16 are anticipated. The rejection is in error, however, because in order to anticipate a claim, the reference must teach every element of the claim M.P.E.P. § 2131. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in "at least one of two-digit, three-digit, or four-digit" representations, was held anticipated by a system that offsets year dates in only two-digit formats). MPEP § 2131.02."

The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a 35 U.S.C. 102 rejection. MPEP § 2131.01.

Further, the elements must be arranged as required by the claim, *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Thus, the instant rejection can only be sustained if each and every element of the rejected claims is described in the single cited reference to Agrawal et al. (EP 0 895 169 A2).

Prior to identifying each of the limitations of Applicants claims which are not found in the cited reference, it is noted that the cited reference is directed to a process model for workflow management systems, which does not require or need the features of the Applicants invention. The process model described in the cited reference is continually updated by modifying the process model in accordance with actual business processes being carried out. During the operation of a business process, an audit trail is created and the records from the audit trail are used to modify the model on an on-going basis. Thus, the user has a process model which is fairly up-to-date based on the audit trail which was previously obtained from the process being modeled.

The present invention is distinguished therefrom by requiring the collection in each of the components of a IT system usage data to indicate the amount of usage of the components in providing any one of a plurality of services. Each service has a value to the IT proprietor and based on that value, a value for the component needed to provide the service can be determined.

The Applicants are required under 37 C.F.R. § 192 (8)(ii) to list the errors in the rejection. Specifically, Applicants are required to identify any specific limitations in the rejected claims which are not disclosed in the prior art relied upon in the rejection.

These limitations are represented in claim 1 as:

collecting in each of the components, usage data indicating an amount of use each component receives and providing each of the services;

reporting the usage data at each component for each service (emphasis added);

constructing evaluation function for evaluating each service...determining from said correlated services and components a value of each component and a value of said IT system.

The cited reference fails to disclose the foregoing steps of claim 1. The cited reference is directed to the simulation and evaluation of business processes, not the evaluation of components used in any type of integrated information technology system. No portion of the cited reference, including drawing figures and written description, describes any component of a IT system which is monitored for any type of usage.

In response to the foregoing observation, which was noted during prosecution of the application, the Examiner has indicated that:

...Examiner points out that these figures were cited along with other sections of the prior art as a mere guide to highlight sections of Agrawal et al. (EP 0 895 169 A2) to the Applicant that teach and suggest the claimed limitations and so while these sections were cited, the rejection asserted as over the prior art reference as a whole.

The foregoing assertion does not relieve the U.S. Patent and Trademark Office from demonstrating that, in accordance with the foregoing M.P.E.P. section, each and every element of Applicants claim is disclosed in the reference. The foregoing allegation is insufficient to demonstrate that specific features of Applicants claims, including collecting at each of the components usage data, reporting the usage data for each component, correlating each service which each component, and determining from the correlated services and components the value of each component, are described in the reference used to reject the claims under 35 U.S.C. § 102.

Claim 3, dependent on claims 1 and 2, requires that the worth of each component be evaluated, based on that components participation in providing multiple services to the IT proprietor. Again, reviewing the cited reference, there is no disclose of any feature corresponding to the subject matter of claim 3.

Claim 4 further requires that a relationship table be provided to identify each component used in providing each service. A detailed study of the reference fails to any such relationship table describing the relationship between components and services.

In response to earlier efforts to convince the Examiner that the foregoing limitations are absent from the cited reference, the Examiner stated (see Office Action dated July 18, 2003), page 4 thereof that:

The Examiner again asserts the sections of the prior art cited in response to argument (2). The workflow is broken down into a sequence of activities that must occur to complete the task in process. Activities are therefore components of the workflow with associated programs, persons, and processes. The activities and components of the workflow process that achieve the service and/or goal of the business are logged and data analyzed to determine each activities and components relationship to the overall workflow process.

The conclusion that “activities are therefore components of the workflow” is not supported by the record in the instant appeal. Indeed, the summary conclusion that activities are

somehow equal to components in the given reference, which discloses no components whatsoever, is speculation and an insufficient evidentiary basis in which to reject the foregoing claims.

Claims 6, 7 and 8 of the present application all require that an agent be provided at each of the components so that transaction data may be accumulated concerning the services provided by that component. As was noted earlier, this limitation, similar to those in the preceding claims, cannot be found anywhere within the cited reference, notwithstanding sweeping conclusions that "activities equal components".

Additional limitations in the remaining claims which are not found in the reference can be summarized as follows.

Per claims 10 and 12, an agent is utilized with each of the components to identify each transaction of the service performed by the IT infrastructure. This limitation is clearly absent from the cited reference.

Claims 13-16 all are directed to subject matter not shown in the cited reference. All of the claims require information to be received from the agents, so that tables can be derived to identify the components used in each service, the total value of each service and the evaluation of each component. None of these limitations can be found in the cited reference.

### VIII. Summary

The present application describes a system very different from that cited in the foregoing reference. Whereas the foregoing reference is directed to a system for modeling the business method, so that one can make certain predictions and conclusions about business methods, it fails to disclose any system which evaluates components in an IT system. The foregoing claims require that component usage data be accumulated and utilized in evaluating both the service and the component in a service as a tool for maintaining and upgrading a IT system. Given the failure of the Final Rejection to note anywhere within the cited reference any of the foregoing

limitations, the Honorable Board of Patent Appeals and Interferences is requested to reverse the Final Rejection and remand the application for issuance.

Applicant believes a fee in the amount of \$330.00 is due with this response. Please charge IBM Deposit Account No. 09-0458, under Order No. 20136-00328-US from which the undersigned is authorized to draw.

Dated: January 20, 2004

Respectfully submitted,

  
By   
George R. Pettit, Reg. No. 27,369  
CONNOLLY BOVE LODGE & HUTZ LLP  
1990 M Street, N.W., Suite 800  
Washington, DC 20036-3425  
(202) 331-7111  
(202) 293-6229 (Fax)  
Attorney for Applicant

## APPENDIX A

### **Claims Involved in the Appeal of Application Serial No. 10/005,862**

1. (Original) A process for managing an integrated information technology (IT) system having a plurality of components and providing a plurality of services, the process comprising the steps of:

collecting, at each of the components, usage data indicating an amount of use each component receives in providing each of the services,

reporting the usage data of each component for each service;

constructing a valuation function for valuing each service,

correlating each service with each component used to provide said service; and

determining from said correlated services and components a value of each component and a value of said IT system.

2. (Original) The process according to claim 1, wherein said value is determined from usage statistics accumulated at each component.

3. (Original) The process according to claim 2, further comprising the step of evaluating a worth of each component based on multiple uses of said component in multiple services performed by said IT system.

4. (Original) The process according to claim 1, further comprising the step of constructing a relationship table identifying the components used in providing each service, wherein a configuration management process is fed by a change management process in order to maintain the relationship table as changes to said IT system are made.

5. (Original) The process according to claim 1, wherein valuing a given service comprises determining a value for each transaction conducted in providing that service.

6. (Original) The process according to claim 1, further comprising the step of providing for each component an agent for accumulating transaction data regarding services provided using that component.

7. (Original) The process according to claim 6, wherein said value is determined in said determining step in accordance with the transaction data.

8. (Original) The process according to claim 6, wherein said transaction data includes the type of transaction and a value associated therewith.

9. (Original) The process according to claim 6, further comprising the step of reporting the transaction data.

10. (Previously amended) A system for managing an IT infrastructure having a plurality of components for providing a plurality of services, said system comprising:

an agent associated with each of the components, said agent identifying each transaction of a service performed by said IT infrastructure; and

an information collection system for collecting from said agents transaction information relating to each service performed, said system determining from said transaction information which of said components are involved in said transaction.

11. (Original) The system according to claim 10, wherein said information collection system provides a report which identifies for each service the value of said service and the value of the components used in providing said service.

12. (Original) A system for managing an IT infrastructure comprising:  
an information technology process model which defines a plurality of groups of processes  
defining information flow for an integrated management model defining the IT infrastructure for  
a plurality of IT services; and  
a plurality of agents for monitoring each component of said IT infrastructure, said agents  
collecting transaction information identifying each transaction by service type;  
said agents reporting over said IT infrastructure transaction information to said  
information process model whereby said information is used by said model.

13. (Original) The system for managing an IT infrastructure according to claim 12  
wherein said information is processed to provide a table which identifies for each component the  
service in which the component participates.

14. (Original) The system for managing an IT infrastructure according to claim 13  
wherein said information from said agents are processed to derive a second table identifying the  
total value of each service based on said information.

15. (Original) The system for managing an IT infrastructure according to claim 14  
wherein said total value is determined for at least some of said services based on the number of  
transactions performed by said services.

16. (Original) The system for managing an IT infrastructure according to claim 13  
wherein said first table includes a valuation of each component based on its participation in each  
of said services.

2700  
AS

<b>TRANSMITTAL OF APPEAL BRIEF</b>		Docket No. 20136-00328-US
In re Application of: Mark L. Ernest et al.		
Application No. 10/005,862-Conf. #2036	Filing Date November 8, 2001	Examiner D. B. Van
Invention: AUTOMATED INFORMATION TECHNOLOGY MANAGEMENT SYSTEM		
<b><u>TO THE COMMISSIONER OF PATENTS:</u></b>		
Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed: <u>November 19, 2003</u> .		
The fee for filing this Appeal Brief is <u>330.00</u> .		
<input checked="" type="checkbox"/> Large Entity <input type="checkbox"/> Small Entity		
<input type="checkbox"/> A check in the amount of _____ is enclosed.		
<input checked="" type="checkbox"/> Charge the amount of the fee to Deposit Account No. <u>09-0458</u> . This sheet is submitted in duplicate.		
<input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.		
<input checked="" type="checkbox"/> The Director is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. <u>09-0458</u> . This sheet is submitted in duplicate.		
		Dated: <u>January 20, 2004</u>
George R. Pettit Attorney Reg. No.: 27,369 CONNOLLY BOVE LODGE & HUTZ LLP 1990 M Street, N.W., Suite 800 Washington, DC 20036-3425 (202) 331-7111		

RECEIVED  
JAN 28 2004  
GROUP 3600